

REMARKS


In this response, Applicants do not cancel, amend or add any claims. Claims 1-15 have been withdrawn from consideration, therefore claims 16-30 remain to be examined.


I. Claims Rejected Under 35 U.S.C. § 102

Claims 16 and 18-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,188,605 issued to Sleep (hereinafter "Sleep"). Applicants respectfully disagree for the following reasons.

It is axiomatic that to anticipate a claim, each element of the claim must be taught by a single reference. Claim 16 includes the element of a hinged portion between the finger tab portion and a tube portion. In Paper 11 on page 5, the Examiner states "Applicants assert that hinge (60), identified in the Sleep patent is a 'v-shaped notch' and not a 'hinge'." Patent reference number 60 is clearly stated in the specification of Sleep to be "a 'V' shaped notch 60." See Sleep, col. 4, line 1. Thus, this is not merely an assertion by the Applicants, but rather the description from Sleep itself.

The Examiner argues on page 5 of Paper No. 11 that a hinge is "a flexible ligamentous joint." The Examiner further argues that Sleep teaches "the hinge (60) narrows to a line of weakness (52), such that the introducer can be pulled away from an inserted catheter, beginning at the hinged joint (60)." Page 5 of Paper No. 11. Thus, the Examiner states that a hinge is located at the point at which the introducer can be pulled away from the inserted catheter. Specifically, the Examiner states that the hinge of Sleep is located at the point of the notch 60 defined by the enlarged tube 44. It is unclear from the Examiner's characterization how this point of the enlarged tube 44 or the notch 60 in the enlarged tube 44 meets even the definition of a hinge set forth by the Examiner. Applicants do not believe that a point in a notch can be reasonably characterized as a flexible ligamentous joint. A joint is "a place or part at which two or more things are joined." See the American Heritage Dictionary of the English Language, Fourth Edition, Houghton & Mifflin Company (2000). If the Examiner maintains this point is a joint between two or more things, then

Applicants assert that the Examiner has not established that Sleep teaches a hinged portion between a finger tab portion and tube portion. This point indicated by the Examiner does not join a finger tab portion to a tube portion. 

Applicants believe that a more appropriate definition of a hinge, given the context of the invention and Sleep, is the primary definition of a hinge: "a jointed or flexible device on which a door, lid or other swinging part turns." See Merriam Webster Dictionary Online, www.m-w.com. The definition cited by the Examiner is a secondary definition that is more appropriate to an anatomical feature. Applicants assert that there is no swinging part involved in the apparatus taught by Sleep. Rather, Sleep teaches a tube through which a catheter is placed. The tube is removed by pulling the catheter through a weak portion of the wall of the tube at a point starting at the tip of the v-shaped notch. See Sleep, col. 4, lines 25-37. This apparatus is not analogous to a door or lid or other swinging part. A door or lid is attached by a hinge to another object and swings in relation to that object. The tab of Sleep does not swing in relation to the tube of Sleep. The notch 60 is only the starting point for creating a tear in the structure of tube 44 so that the catheter may be pulled through this tear. Applicants assert that this is not in any manner analogous to a hinged structure as claimed. Thus, Sleep does not teach this element of claim 16. Therefore, claim 16 is not anticipated by Sleep. 

In regard to claims 18-20, these claims depend from independent claim 16 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to claim 16, these claims are not anticipated by Sleep. Accordingly, reconsideration and withdrawal of the anticipation rejection of claim 16 are requested.

II. Claims Rejected Under 35 U.S.C. § 103

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sleep, in view of U.S. Patent No. 5,263,938 issued to Orr, et al. (hereinafter "Orr"). Applicants respectfully disagree for the following reasons.

In order to establish a *prima facie* case of obviousness, the Examiner must show that each element of the claim is taught or suggested by the combined references. In regard to claim 17, this claim depends from independent claim 16 and incorporates the limitations thereof. Thus, at least for reasons mentioned in regard to claim 16, Sleep does not teach each of the elements of claim 17, including a hinged portion between the finger tab portion and the tube portion. Orr does not cure this defect of Sleep. The Examiner has not indicated and Applicants have been unable to discern any part of Orr that teaches or suggests a hinged portion between a finger tab portion and a tube portion. Thus, Sleep in view of Orr does not teach or suggest each of the elements of claim 17. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 17 are requested.

Claims 21-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sleep. Applicants respectfully disagree for the following reasons. The claims include the elements of the finger tab portion and the tube portion being formed as a single integral piece. The Examiner admits that Sleep does not teach this element of claims 21-24. The Examiner relies on *Howard v. Detroit Stove Works*, 150 US 164 (1893). This case held that a grate cast in two pieces was not obvious over a grate cast in one piece. *Howard*, 156 U.S. 164, 170. The Examiner has not indicated and Applicants have been unable to discern any cited part of *Howard* that stands for the general proposition that "forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art." Rather, as discussed in *Mooney v. Brunswick Corp.*, which reviewed cases on this subject including *Howard*, "there is no per se rule that making something in one piece that was formerly made in two or more pieces renders it obvious. Rather, the Court must look beyond the mere fact of unitary construction to determine what improvement results from the one piece construction and whether the improvement or construction itself was obvious from the prior art." See *Mooney v. Brunswick*, 206 USPQ 121, 138 (E.D. Wis. 1980) *aff'd* 212 USPQ 401 (7th Cir. 1981). See also *Krementz v. The S. Cottle Company*, 148 US 556 (1893) wherein the Supreme Court held a collar button with a one-piece head and stem patentable over a multi-piece collar button, *Stuber v. Central Brass and Stamping*

used wrong case law

Co., 224 F.712 (7th Cir. 1915) wherein the Court found that a one-piece hose coupler was patentable over a reference which disclosed a two-piece hose coupler. Thus, Applicants believe that the Examiner has inappropriately applied a per se obviousness standard. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claims 21-24. Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 21-24 are requested.

Claims 25 and 28-30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,167,634 issued to Corrigan, Jr., et al., (hereinafter "Corrigan"). Applicants respectfully disagree for the following reasons.

In regard to claim 25, this claim includes the element of a first finger tab and second finger tab formed in a single integral piece with the tube. The Examiner admits Corrigan does not teach this element of claim 25. Rather, the Examiner again relies on *Howard v. Detroit Stove Works* in utilizing a per se obviousness standard for a one-piece construction. As discussed above in regard to claims 21-24, Applicants believe that this standard is inappropriate. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claim 25.

In regard to claims 28-30, these claims depend from independent claim 25 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to claim 25, these claims are not obvious over Corrigan. Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 25 and 28-30 are requested.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Corrigan in view of U.S. Patent No. 5,782,817 issued to Franzel, et al. (hereinafter "Franzel"). Applicants respectfully disagree for the following reasons.

Claim 26 depends from claim 25 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to claim 25, Corrigan does not teach or suggest each of the elements of claim 26. Namely, Corrigan does not teach a finger tab portion formed as a single integral piece with a tube. Franzel does not cure the defects of Corrigan. The Examiner has not

indicated and Applicants have been unable to discern any part of Franzel that teaches or suggests finger tab portions formed as a single integral piece with a tube. Thus, the Examiner has failed to establish a *prima facie* case of obviousness for claim 26. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 26 are requested.

Claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Corrigan in view of Orr. Applicants respectfully disagree for the following reasons.

Claim 27 depends from independent claim 25 and incorporates the limitations thereof. Thus, for the reasons mentioned in regard to claim 25, Corrigan does not teach or suggest each of the elements of claim 25. Namely, Corrigan does not teach or suggest finger tab portions formed as a single integral piece with the tube portion. Orr does not cure this defect of Corrigan. The Examiner has not indicated and the Applicants have been unable to discern any part of Orr that teaches or suggests forming a finger tab portion with a tube portion as a single integral piece. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claim 27. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 27 are requested.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 16-30 patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207 3800.

Respectfully submitted,

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Dated: 6/24, 2003

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CERTIFICATE OF TRANSMISSION:

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